

REMARKS

1. Election in Response to Restriction Requirement

Applicant hereby confirms its election of claims 21-30 and 41-47 with traverse. Applicant respectfully reserves the right to file one or more divisional and/or continuing applications claiming the subject matter of the non-elected claims.

2. Priority

Applicant has claimed priority to prior-filed non-provisional application, Patent Application Serial No. 10/154,217, filed on May 20, 2002, now Patent No. 6,623,328, issued on September 23, 2003. The present application, Patent Application Serial No. 10/668,049, was filed on September 22, 2003.

The Examiner has claimed that the benefit claim to the prior-filed non-provisional application is improper because the applications were never co-pending. Applicant is perplexed by the Examiner's comment since the applications were clearly co-pending on September 22-23, 2003. See below:

M.P.E.P. 201.11, II. B. Claiming the Benefit of Nonprovisional Applications - Copendency

When a later-filed application is claiming the benefit of a prior-filed nonprovisional application under 35 U.S.C. 120, 121, or 365(c), the later-filed application must be copending with the prior application or with an intermediate nonprovisional application similarly entitled to the benefit of the filing date of the prior application. Copendency is defined in the clause which requires that the later-filed application must be filed before: (A) the patenting of the prior application; (B) the abandonment of the prior application; or (C) the termination of proceedings in the prior application.

If the prior application issues as a patent, it is sufficient for the later-filed application to be copending with it if the later-filed application is filed on the same date, or before the date that the patent issues on the prior application. Thus, the later-filed application may be filed under 37 CFR 1.53(b) while the prior application is still pending before the examiner, or is in issue, or even between the time the issue fee is paid and the patent issues. Patents usually will be published within four weeks of payment of the issue fee. Applicants are encouraged to file any continuing applications no later than the date the issue fee is paid, to avoid issuance of the prior application before the continuing application is filed. (emphasis added)

Accordingly, Applicant submits that the priority claim is proper and the Examiner's "co-pendancy" rejection should be withdrawn.

3. Drawings Objection

The Examiner has objected to the drawings under 37 CFR 1.83(a) for not showing each and every feature of the invention that is specified in the claims. In particular, the Examiner has stated that the connection members of magnets and snaps are not shown.

In response, FIG. 4 has been amended to show magnets 150 and snaps 152. No new matter has been added. For support, see at least ¶ [0013]. An Appendix including the replacement figure is attached to the end of this paper.

4. Claims Objections - Informalities – Claims 30

The Examiner objected to claim 30 for depending on canceled claim 1. This typographical error has been corrected. Claim 30 now properly depends from claim 21.

5. Claims Rejections - 35 U.S.C. § 102(b) – Claims 21-24, 28-29, 41-44 and 46-47

The Examiner has rejected claims 21-24, 28-29, 41-44 and 46-47 in the Office Action dated June 29, 2006, under 35 U.S.C. § 102(b) as being anticipated by VanNatter (U.S. Patent No. 5,553,570). Applicant respectfully traverses this rejection. For the sake of brevity, the rejections of the independent claims are discussed in detail on the understanding that the dependent claims are also patentably distinct over the prior art, as they depend directly from their respective independent claims. Nevertheless, the dependent claims include additional features that, in combination with those of the independent claims, provide further, separate and independent bases for patentability.

The Examiner has stated that the VanNatter patent anticipates claims 21-24, 28-29, 41-44 and 46-47 of the invention. However, the VanNatter patent does not teach or suggest each and every element of the cited claims. In this regard, the VanNatter patent does not teach or suggest:

a pet toy, “wherein the interface surfaces of the main member and the interface surfaces of the secondary members are attachable by a human to create an attached toy state, non-destructively detachable by a house pet using its mouth and paws to create a detached toy state, and repeatedly reattachable by a human to recreate an attached toy state after being detached by a house pet; thereby enabling a house pet to tear apart the main and secondary members of the toy by gripping the exterior surfaces of the toy with its paws and mouth.”

In stark contrast, the VanNatter patent discloses a “retrievable animal toy” which “has a two-part body at least one part of which has at least one hollow portion for holding an item, animal food item, or items, and which is not accessible by an animal....” See Abstract. The VanNatter patent additionally states, “[a]fter an animal retrieves the device 10, a person unscrews the two parts 12 and 14....” See Col. 3, line 65 to Col. 4, line 2. Thus, the device of the VanNatter patent is configured for the exact opposite purpose, since the VanNatter device is configured NOT to be accessible by an animal (i.e., must be accessed by a person), and the pet toy of the claimed invention is configured specifically to be detachable by a house pet using its mouth and paws to create a detached toy state, thereby enabling a house pet to tear apart the main and secondary members of the toy. In this regard, the VanNatter patent teaches away from the claimed invention.

Additionally, the claimed invention also requires: a pet toy “wherein the pet toy main member is shaped and sized to prevent swallowing by a house pet” and “wherein the pet toy secondary members are shaped and sized to prevent swallowing by a house pet.” In contrast, the device of the VanNatter patent intentionally includes components that are selected and configured to be eaten by a dog or other animal. In this regard, the VanNatter patent teaches away from the claimed invention, which specifically requires components of the pet toy to be “shaped and sized to prevent swallowing by a house pet.” In such a situation, it is improper to combine references where the references teach away from their combination. The Manual of Patent Examining Procedure, § 2145, sub§ 2, states that “References Cannot Be Combined Where Reference Teaches Away from Their Combination.” Thus, in accordance with M.P.E.P. § 2145, sub§ 2, the teachings and suggestions of the references CANNOT be combined.

Applicant respectfully submits that claims 21-24, 28-29, 41-44 and 46-47 are not anticipated by the VanNatter patent, which fails to teach or suggest all of the claimed limitations.

In conclusion, Applicant respectfully submits that the 35 U.S.C. § 102(b) rejection of claims 21-24, 28-29, 41-44 and 46-47 has been overcome.

6. Claims Rejections - 35 U.S.C. § 102(b) – Claims 21 and 26

The Examiner has rejected claims 21 and 26 under 35 U.S.C. § 102(b) as being anticipated by Russell (US 5,195,917). Applicant respectfully traverses this rejection. For the sake of brevity, the rejections of the independent claims are discussed in detail on the understanding that the dependent claims are also patentably distinct over the prior art, as they depend directly from their respective independent claims. Nevertheless, the dependent claims include additional features that, in combination with those of the independent claims, provide further, separate and independent bases for patentability.

The Examiner has stated that the Russell patent anticipates claims 21 and 26 of the invention. However, the Russell patent does not teach or suggest each and every element of the cited claims. In this regard, the Russell patent does not teach or suggest: a pet toy device “wherein the pet toy main member is shaped and sized to prevent swallowing by a house pet” and “wherein the pet toy secondary members are shaped and sized to prevent swallowing by a house pet.” In stark contrast, the Russell patent discloses a sports referee doll that is configured to be used by humans that tear apart the doll in response to sporting activities and/or referee officiating. As such, the sports referee doll of the Russell patent is NOT shaped and sized for safe and suitable use by a house pet (e.g., a dog). Specifically, the detachable pieces of the sports referee doll of the Russell patent are NOT shaped and sized to prevent swallowing by a house pet. In particular, elements 14 and 16 (see FIGS. 1-3) are depicted to be small and swallowable by a dog, and thus, quite dangerous to a dog, as a result of elements 14 and 16 being shaped and sized for safe use and manipulation by humans, specifically sports fans but not dogs.

Applicant respectfully submits that claims 21 and 26 are not anticipated by the Russell patent, which fails to teach or suggest all of the claimed limitations. In conclusion, Applicant respectfully submits that the 35 U.S.C. § 102(b) rejection of claims 21 and 26 has been overcome.

7. Claims Rejections - 35 U.S.C. § 103(a) – Claims 25 and 45

The Examiner rejected claims 25 and 45 under 35 U.S.C. § 103(a) as being unpatentable over VanNatter. Applicant respectfully traverses this rejection. For the sake of brevity, the rejections of the independent claims are discussed in detail on the understanding that the dependent claims are also patentably distinct over the prior art, as they depend directly from their respective independent claims. Nevertheless, the dependent claims include additional features that, in combination with those of the independent claims, provide further, separate and independent bases for patentability.

VanNatter fails to teach or suggest each and every element of claims 25 and 45 for the reasons stated above in Section 5 of this response. Accordingly, Applicant respectfully submits that claims 25 and 45 are not unpatentable over the VanNatter patent, which fails to teach or suggest all of the claimed limitations. In conclusion, Applicant respectfully submits that the 35 U.S.C. § 103(a) rejection of claims 25 and 45 has been overcome.

8. Claims Rejections - 35 U.S.C. § 103(a) – Claims 27

The Examiner rejected claims 27 under 35 U.S.C. § 103(a) as being unpatentable over Russell and Alonso (US 3,375,604). Applicant respectfully traverses this rejection. For the sake of brevity, the rejections of the independent claims are discussed in detail on the understanding that the dependent claims are also patentably distinct over the prior art, as they depend directly from their respective independent claims. Nevertheless, the dependent claims include additional features that, in combination with those of the independent claims, provide further, separate and independent bases for patentability.

Russell fails to teach or suggest each and every element of claim 27 for the reasons stated above in Section 6 of this response. Alonso does not supply any of the shortcomings of the Russell patent. Accordingly, Applicant respectfully submits that claim 27 is not unpatentable over the Russell and Alonso patents, which fail to teach or suggest, either alone or in combination, all of the claimed limitations. In conclusion, Applicant respectfully submits that the 35 U.S.C. § 103(a) rejection of claim 27 has been overcome.

9. Claims Rejections - 35 U.S.C. § 103(a) – Claims 30

The Examiner rejected claims 30 under 35 U.S.C. § 103(a) as being unpatentable over VanNatter and Snook (US 6,601,539). Applicant respectfully traverses this rejection. For the sake of brevity, the rejections of the independent claims are discussed in detail on the understanding that the dependent claims are also patentably distinct over the prior art, as they depend directly from their respective independent claims. Nevertheless, the dependent claims include additional features that, in combination with those of the independent claims, provide further, separate and independent bases for patentability.

VanNatter fails to teach or suggest each and every element of claim 30 for the reasons stated above in Section 5 of this response. Snook does not supply any of the shortcomings of the VanNatter patent. Accordingly, Applicant respectfully submits that claim 30 is not unpatentable over the VanNatter and Snook patents, which fail to teach or suggest, either alone or in combination, all of the claimed limitations. In conclusion, Applicant respectfully submits that the 35 U.S.C. § 103(a) rejection of claim 30 has been overcome.

CONCLUSION

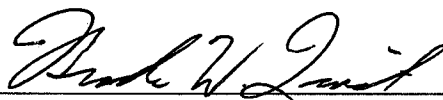
Applicants have made an earnest and *bona fide* effort to clarify the issues before the Examiner and to place this case in condition for allowance. Reconsideration and allowance of all of claims 31-40 and 48-54 is believed to be in order, and a timely Notice of Allowance to this effect is respectfully requested.

The Commissioner is hereby authorized to charge the fees indicated in the Fee Transmittal, any additional fee(s) or underpayment of fee(s) under 37 CFR 1.16 and 1.17, or to credit any overpayments, to Deposit Account No. 194293, Deposit Account Name STEPTOE & JOHNSON LLP.

Should the Examiner have any questions concerning the foregoing, the Examiner is invited to telephone the undersigned attorney at (310) 734-3200. The undersigned attorney can normally be reached Monday through Friday from about 9:00 AM to 6:00 PM Pacific Time.

Respectfully submitted,

Date: November 29, 2006



Brooke W. Quist
Reg. No. 45,030
STEPTOE & JOHNSON LLP
2121 Avenue of the Stars
Suite 900
Los Angeles, CA 90067
Tel 310.734.3200
FAX 310.734.3300